

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

Applicants acknowledge that the Examiner has withdrawn the previous rejections under 35 USC § 112, second paragraph and under 35 USC § 102 based on Hermann (DE'280), and that claims 20 to 25 and 44 have been deemed allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Summary of the Claim Amendments

Therefore, and solely to advance prosecution, objected-to claims 20, 21 and 44 as previously presented remain pending. Objected-to claims 22–25 have been canceled and rewritten as new claims 50–53. Claim 1 has been amended as suggested by Examiner Wilson and claim 39 has been amended to conform in scope with claim 1 as amended.

Solely to advance prosecution, claims 2 to 19, 26 to 38, 40 to 43 and 45 to 49 have thus been cancelled without prejudice or disclaimer and Applicants reserve the right to pursue the subject matter of these canceled claims in one or more continuing applications.

Solely to advance prosecution, claim 39 has been amended to clearly indicate that “X” in formula (1.7) is different from “X” in formula (1.0) by including “1” in subscript in formula (1.7): “X₁”.

Following entry of the foregoing amendment, claims 1, 20, 21, 39, 44 and 50–53 are pending and in the present patent application now has nine (9) pending claims. It is believed no new matter has been added. Applicants do not believe that the amendments are necessary to distinguish the claimed invention from the cited patent. Moreover, Applicants respectfully submit that this amendment is appropriate under 37 C.F.R. § 1.116 and that no new search is required. Accordingly, Applicants respectfully request that the claim amendments be entered in this application.

Rejections under 35 USC § 112, first paragraph

Claims 1, 2, 4, 7, 9 to 12, 18 to 25, 29, 31, 39 and 43 of record stand rejected as allegedly lacking enablement for the term “aryl”. Applicants disagree and therefore traverse this rejection and request that it be withdrawn. However, Applicants note that the Examiner states that the

specification as filed is enabling for making and using compounds where R₁ or R₂ is a phenyl or hydroxyphenyl group. Accordingly, without acquiescing to the Examiner's position, to expedite prosecution claim 1 the term "aryl" has been replaced with "phenyl or hydroxyphenyl" in accordance with illustrative embodiments disclosed in the specification. Moreover, claims 2, 4, 7, 9 to 12, 18, 19, 29, 31 and 43, *inter alia*, have been canceled rendering the rejection of these claims moot.

Applicants respectfully submit that claim 1 is fully enabled in compliance with 35 U.S.C. § 112, first paragraph. Applicants therefore request that the rejection under this section be withdrawn.

Because claims 20, 21, 39, 44 and 50–53 depend directly or indirectly on amended claim 1 and include by reference all the limitations recited therein, these claims are also believed to be in compliance with 35 USC § 112, first paragraph. Withdrawal of the Examiner's rejection and allowance of claims 1, 21, 39, 44 and 50–53 are earnestly solicited.

Claims 45–49 of record stand rejected as allegedly failing to comply with the written description requirement. Applicants respectfully traverse. However, without acquiescing to the Examiner's position, and merely to advance prosecution, claims 45–49 have been cancelled rendering this rejection moot. Applicants reserve the right to pursue the subject matter of canceled claims 45–49 in a continuing application.

Applicants respectfully submit that claims 1, 20, 21, 39, 44 and 50–53 are in compliance with 35 USC § 112, first paragraph and are in condition for allowance. Such action is respectfully requested.

Rejection under 35 USC § 103

Claims 1, 2, 4, 11, 29, 31 and 39 of record stand rejected as allegedly being obvious in view of Hermann et al. (DE'280). The Examiner asserts that compound #16 of DE'280 is an obvious variant of the compounds defined in the claims of record since it allegedly differs only at R₁ and R₂. Applicants traverse this rejection and request that it be withdrawn.

First, claims 2, 4, 11, 29 and 31, *inter alia*, have been cancelled rendering the rejection of these claims moot.

Second, Applicants respectfully submit that the cited DE'280 reference does not teach or suggest the subject matter of amended claim 1. More particularly, claim 1 of record has been

amended define R₁ or R₂ as being “phenyl or hydroxyphenyl” in accordance with illustrative embodiments disclosed in the specification. As noted by the Examiner, the cited DE’280 reference teaches hydroxyalkyl groups on the 4-position amino group. Clearly, phenyl and hydroxyphenyl groups do not encompass hydroxyalkyl groups, nor would one of skill in the art be motivated to replace these specific aryl groups with hydroxyalkyl groups. Applicants therefore respectfully submit that amended claim 1 is unobvious in view of the cited DE’280 reference and is allowable.

Because claim 39 depends directly on amended claim 1 and incorporates by reference all the limitations recited therein, claim 39 is therefore also allowable in view of the cited DE’280 reference. Withdrawal of the Examiner’s rejection and allowance of claims 1 and 39 are earnestly solicited.

Claim objection

Claims 20–25 and 44 stand objected to as being dependent upon a rejected base claim, but have been deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants acknowledge the Examiner’s position and accordingly all claims of record but claims 1, 20, 21, 39 and 44 have been canceled. Applicants have added new claims 50–53, which are identical in scope to objected-to claims 22–25.

Applicants provide within the listing of claims an amended claim 1, from which claims 20, 39 and 44 depend, and which obviates the rejections under 35 USC § 112, first paragraph and 35 USC § 103 and is therefore believed to be allowable.

It is therefore believed that dependent claims 20, 21, 44 and 50–53 are allowable since these claims are now dependent on amended claim 1. Withdrawal of the Examiner’s objection and allowance of claims 20, 21 and 44 as well as new claims 50–53 is earnestly solicited.

CONCLUSION

In view of the above, reconsideration of the Examiner's rejections and objection and allowance of pending claims 1, 20, 21, 39, 44 and 50–53 is earnestly solicited. Applicants look forward to receiving a Notice of Allowance.

The Examiner is invited to call Travis Young (Reg. No. 53,819) at 503-595-5300 if any further amendment will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the present response. If the claims of the application are not believed to be in full condition for allowance, for any reason, Applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Travis Young, Ph.D./
Travis Young, Ph.D.
Registration No. 53,819